REMARKS

This application is currently under final rejection. Accordingly, a Request for Continued Examination is filed herewith. As such, applicants respectfully request that the Examiner withdraw the finality of the rejections and consider the enclosed response and amendment.

Upon entry of the amendments submitted herewith, claims 18-65 will be pending in this application. Applicants respectfully submit that the claim amendments submitted herewith do not add any new matter within the meaning of 35 U.S.C. §132 to the application.

Accordingly, entry of the above amendments is respectfully requested.

1. Rejection of claim 21 under 35 U.S.C. §112, 1st paragraph

The Official Action states that claim 21 is rejected under 35 U.S.C. §112, 1st paragraph as failing to comply with the written description requirement. In particular, the Official Action states, in relevant part:

> Instant specification, as originally filed, does not convey the limitation of a dosage form containing from 0.01 mg to 5 mg of roflumilast per dosage unit. Accordingly, a person of ordinary skill in the art would not recognize that Applicants were in possession of same at the file date of the application.

RESPONSE

Applicants respectfully traverse this rejection.

The specification clearly contains written description for a dosage form containing from 0.01 mg to 5 mg of roflumilast at page 22, lines 4-5 which states that "[d]osage forms preferred according to the invention contain from 0.01 mg to 5 mg of roflumilast…".

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

2. Rejection of claims 18-65 under 35 U.S.C. §112, 2nd paragraph

The Official Action states that claims 18-65 are rejected under 35 U.S.C. §112, 2nd paragraph as being indefinite. In particular, the Official Action states, in relevant part:

> Claim 18 recites "-oxide of the pyridine of the compound". It is unclear what is meant by pyridine of the compound. Clarification is requested.
>
> Claims 19-65 are rejected for depending on claim 18, thus incorporating the indefinite limitation.
>
> Claim 24 recites "Kollidon®". If a trademark is used in a claim, the specification should recite both the generic name for the material and the source of the material. Instant specification does not recite the source of the material.
>
> Claim 25 recites an improper Markush group. If the language "group consisting of" is used, then the members of the group must be listed in the inclusive, not in the alternative.

RESPONSE

Applicants respectfully traverse the rejection of claims 18-65.

Regarding the rejection of claims 18-65, applicants respectfully point out to the Examiner that the phrase "N-oxide of the pyridine of the compound" is clear and definite. A person of ordinary skill in the art would be fully apprised of the meaning of this phrase.

In order to demonstrate that a person of ordinary skill in the art would be fully apprised of the meaning of this phrase, applicants submit herewith an Information Disclosure Statement citing one (1) reference to Hatzelmann et al. entitled "Anti-Inflammatory and Immunomodulatory Potential of the Novel PDE4 Inhibitor Roflumilast In Vitro", published in 2000. Particular reference is made to page 270, second column, 4th paragraph of the Hatzelmann et al. reference. In discussing roflumilast and its corresponding N-oxide, Hatzelmann et al. state "[s]ince roflumilast in vivo is efficiently metabolized to the corresponding pyridyl N-oxide in various species, including humans..." (emphasis added). Accordingly, it would be known to a person of ordinary skill in the art that an N-oxide of roflumilast may be formed at the nitrogen atom of the pyridine contained in the roflumilast molecule. As such, the phrase "N-oxide of the pyridine" is clear and definite.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Regarding the rejection of claim 24, applicants respectfully point out to the Examiner that claim 24 has been amended to delete any reference to trademarked terms and to recite different polyvinylpyrrolidones of varying molecular weights. Thus, the basis for this rejection is moot.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Regarding the rejection of claim 25, applicants respectfully point out to the Examiner that claim 25 has been amended to recite the members of the Markush listing in "inclusive" format. Thus, the basis for this rejection is moot.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

3. Rejection of Claims 18-32, 36, 37 and 58-65 under 35 U.S.C. §103(a)

The Official Action states that claims 18-32, 36, 37 and 58-65 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Rennard, et al. (US Published Application No. 20030018071) in combination with Ghebre-Sellassie et al. (US Patent No. 6,667,362)

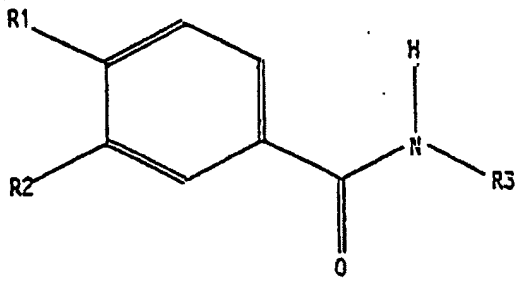
RESPONSE

Applicants respectfully traverse this rejection. The

references of record do not teach or suggest applicants' inventive subject matter as a whole as recited in the claims. The Examiner has failed to establish a *prima facie* case of obviousness against the presently rejected claims.

To establish a *prima facie* case of obviousness, the PTO must satisfy three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art references must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970).

Applicants note that claim 18 is drawn to a solid dosage form in tablet or pellet form for oral administration of a PDE 4 inhibitor, comprising a PDE 4 inhibitor together with polyvinylpyrrolidone as binder, and one or more other suitable pharmaceutical excipients, wherein the PDE 4 inhibitor is a compound of the formula I



(I)

in which

R1 is difluoromethoxy,

R2 is cyclopropylmethoxy and

R3 is 3,5-dichloropyrid-4-yl,

or a salt of this compound, an N-oxide of the pyridine of this compound or a salt thereof,

wherein said dosage form has immediate release of the PDE 4 inhibitor.

As has been discussed with the Examiner in previous conversations and in the in-person interview of November 29, 2005, the scope of claim 18 is not rendered obvious by the cited Rennard et al. and Ghebre-Sellassie et al. references because there is no motivation to combine the teachings of Rennard and Gebre-Sellassie et al.

The Examiner states in the Official Action that

> it would be prima facie obvious...at the time of the invention to add polyvinylpyrrolidone to the formulations of Rennard. The motivation to do so comes from 362 which

> teaches that the addition of polyvinylpyrrolidone will increase the bioavailability of the drug. The expected result would be an immediate dosage form with increased bioavailability.

Applicants respectfully disagree with the Examiner's position. The primary Rennard et al. reference does not even discuss solubility of drugs. Further, Rennard et al. do not recognize the need for an immediate release dosage form containing polyvinylpyrrolidone (PVP) because it already teaches an "immediate release" tablet in Example 4 at Table 2.

Thus, a person of ordinary skill would not be motivated, upon reading Rennard et al., to combine it with the teachings of another reference to obtain an "immediate release" tablet of a slightly soluble drug.

Further, applicants again point to the data in the specification at page 20 and in Figure 1. The data shows that the instantly claimed dosage forms comprising roflumilast and PVP lead to higher serum levels of roflumilast in the blood more quickly than the dosage forms comprising roflumilast and no PVP.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness against the presently pending claims. Further, if the Examiner insists on maintaining that he has established a *prima facie* case of obviousness against the presently pending claims, the data presented in the specification clearly demonstrates unexpected results which would rebut this alleged

prima facie case.

As such, applicants respectfully request that the Examiner reconsider and withdraw the rejection.

4. Rejection of Claims 33-35 and 38-57 under 35 U.S.C. §103(a)

The Official Action states that claims 33-35 and 38-57 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Rennard, et al. (US Published Application No. 20030018071) in combination with Ghebre-Sellassie et al. (US Patent No. 6,667,362) and further in view of Remington.

RESPONSE

Applicants respectfully traverse this rejection. The references of record do not teach or suggest applicants' inventive subject matter as a whole as recited in the claims. The Examiner has failed to establish a *prima facie* case of obviousness against the presently rejected claims.

For the sake of brevity, the arguments set forth above in section 3 are incorporated herewith as they pertain to the teachings of the Rennard et al. and Gebre-Sellassie et al. references. The additional Remington's reference does not remedy the deficient teachings of the aforementioned references and, thus, cannot establish a *prima facie* case of obviousness against the presently rejected claims.

The Remington's reference does not discuss the solubility of drugs. Further, the Remington's reference does not recognize the need for an immediate release dosage form containing polyvinylpyrrolidone (PVP) as presently claimed.

Thus, a person of ordinary skill would not be motivated, upon reading the Remington's reference, to combine it with the teachings of the other references to obtain an "immediate release" tablet of a slightly soluble drug comprising corn starch.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness against the presently pending claims. Again, if the Examiner insists on maintaining that he has established a *prima facie* case of obviousness against the presently pending claims, the data presented in the specification clearly demonstrates unexpected results which would rebut this alleged *prima facie* case.

As such, applicants respectfully request that the Examiner reconsider and withdraw the rejection.

CONCLUSION

In view of the foregoing, applicants respectfully request the Examiner to reconsider and withdraw the rejection of the claims and to allow pending claims 18-65.

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,

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